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concl'd.

positioned within said port, wherein a first end of a jumper wire [embedded within said adapting member interconnects the] is connected to a terminal block and a second end of said jumper wire is connected to [with] one of the conductors [insulated by] of the main body of the lead.

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### REMARKS

Applicant wishes to thank the Examiner for the thorough examination of the subject application. The office action has rejected claims 1-15 under 35 U.S.C. 103(a) as being unpatentable based on a combination of Stutz, Jr. (U.S. Patent No. 5,413,595) in view of Fain et al. (5,679,026). For the reasons given below, the rejection in its entirety is respectfully traversed. Independent claims 1 and 9 have been amended to further clarify the claimed invention. Independent claims 1 and 9 requires a lead having an adapting member extending from the lead. Without limitation, none of references relied on in the office action show or describe a lead having an adapting member extending from the lead. Also, none of the references relied on in the office action show or describe a jumper wire connecting a terminal block of an adapting member and a conductor of a lead.

The office action contends that "it would have been obvious to a person of ordinary skill in the art to combine the Fain adapter and the Stutz lead into a unitary lead and adapter." Further, the office action contends that "[a]t the time of the invention, it would have been obvious to a person of ordinary skill in the art that the Fain device could be modified such that the lead connector port 46 and the lead connector 52 could be replaced by an aperture through the adapter so that the adapter would not interfere with another lead connected directly to a port on the header. Alternatively, ... the inclusion of an aperture would have been a modification of the

shape of the adapter which a person of ordinary skill in the art would have found obvious ...”

These contentions are respectfully traversed. Nowhere in the Stutz, Jr. reference is there a suggestion or teaching to combine an adapter and lead into a unitary lead and adapter. Also, the device in Fain et al. serves a different purpose and performs a different function than the claimed device for a lead having an adapter.

Column 3, lines 29-36 of Fain et al provides “[t]he present invention encompasses a header adapter which is a separately molded part and which is designed to be secured to receiving portions of the header and pulse generator case of an implantable cardiac stimulation device such as a pacemaker or implantable cardioverter-defibrillator, in order to provide a different lead connector port configuration and/or dimensions than that provided by the header of the device.

Fain et al. does not suggest or teach modifying its header adapter in the way contended in the first office action. The Fain et al. patent cannot reasonably be said to suggest a modification that would render the device inoperative for its intended purpose. Similarly, it cannot be reasonably contended that someone skilled in the art, when faced with the Fain et al. patent or any other reference, is naturally inclined to consider modifications that would render a disclosed device inoperative for its stated purpose. Thus, it is submitted that none of the claims are obvious in view of the Fain et al. or Stutz, Jr. patent.

When a claimed element is absent from the teachings of a reference, there must be a suggestion to combine the teachings of other relied upon references. The mere fact that references might be able to be combined or modified in a manner suggested, does not render the

resultant combination obvious unless the references also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ.2d 1430 (Fed. Cir. 1990). It appears that hindsight has been used to reconstruct the claimed invention from the cited references. "It is impermissible however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps." In re Gorman, 18 USPQ.2d 1885 (Fed. Cir. 1991). Each of the claims include limitations that are not shown or described by the cited references. Further, a prima facie case of obviousness can only be established by combining or modifying the teachings of the cited references to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992); (see MPEP 2143.01).

This suggestion or teaching is absent in the references relied on in the office action. Thus, claims 1-15 are believed to be in a condition of allowance and a notice to that affect is respectfully requested. The amendments and remarks set forth above are provided to expedite and advance the prosecution of the patent application.

Respectfully submitted,  
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